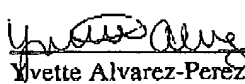


FEB 17 2004

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to Office of Petitions, USPTO at fax number (703) 872-9306 on the date indicated below.

  
Yvette Alvarez-Perez

2/17/04  
Date

OFFICIAL

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/055,822  
Applicant : Volkmar Schwitzky et al.  
Filed : January 23, 2002  
Title : FINISHING PROCESS  
Examiner : Parker, Frederick J.  
Art Unit : 1762  
Attorney Docket No. : 103797-238-NP

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY TO ADVISORY ACTION**

Sir:

This is responsive to the Advisory Action mailed on December 15, 2003 with the Decision on the Petition to Revive the Application. This Reply to Advisory Action and the Reply to Final Office Action filed on Nov. 13, 2003 serve as the submission required for the Request for Continued Examination (RCE), which is being filed concurrently under 37 CFR 1.114. Applicants request entry of both replies and reconsideration of the above-identified patent applications in view of the amendments and remarks in the replies.

In the Advisory Action, the Examiner contends,

"[m]erely specifying "watermark" for "distinguishing feature" does not patentably distinguish over the prior art because the combination of Weitzberg in view of Shenton already

LIBNY/4280499.1

provides a coating process comprising applying a watermark to a printed security substrate which is subsequently at least partially lacquered for the same reasons, namely providing tamperproof security seals. The proposed amendment therefore fails to overcome the prior art rejections."

The present invention as defined in claim 1, as amended in the Reply to the Final Office Action, relates to a method for finishing a printed security sheet carrying at least one watermark, comprising: (1) partially coating the printed security sheet in one step with a layer of lacquer to the at least one watermark such that the at least one watermark is emphasized by increasing the transparency thereof; and (2) lacquering the printed security sheet in another step over its whole surface to increase the durability of the security sheet. The Applicants have found that coating a watermark with a layer of lacquer increases the transparency of the watermark and therefore, the watermark is more clearly visible, due to the increased difference in transparency of the watermark and its surrounding area, so that the watermark can be recognized clearly even without holding the sheet against a source of light. The purpose of the claimed invention is not tamperproofing the security seals as contended by the Examiner.

Weitzberg teaches a tamper-proof identification document comprising a base card attached to a photographic layer comprising both a picture section and a data text section. A significant marking extends over both the picture and text sections. The photographic layer is overlaid with a transparent security coating layer. In column 2, lines 38-41, Weitzberg describes that the specific marking is preferably a water-marking. However, Weitzberg does not teach or suggest the use of a watermark which is partially coated and emphasized with lacquer prior to coating the protective transparent security coating.

Shenton teaches a method of providing a security device on a substrate comprising embossing at least one transitory image, and a linear area which is visible when the device is examined from substantially all viewing angles. Shenton further teaches that the substrate printed with metallic inks could be overprinted with a tinting lacquer to provide colored metallic effects. Shenton nowhere mentions a watermark, much less partial coating a watermark to emphasize the watermark.

Therefore, the combination of Weitzberg and Shenton still fails to teach or suggest the use of a watermark which is partially coated and emphasized with lacquer prior to coating the protective transparent coating. The claimed invention is not obvious over Weitzberg in view of Shenton. The applicants submit that the claim rejections under 35 U.S.C. § 103(a) are overcome and withdrawal thereof is respectfully requested.

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the claims and/or drawings be amended in formal respects in order to place the case in condition for allowance, then it is respectfully requested that such amendment be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicant,



Eva Tan (Reg. No. 46,406)  
GOODWIN PROCTER LLP  
103 Eisenhower Parkway  
Roseland, NJ 07068  
(973) 992-1990 Ext. 7904

PTO/SB/30 (08-03)

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# Request For Continued Examination (RCE) Transmittal

Address to:  
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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

|                        |                           |
|------------------------|---------------------------|
| Application Number     | 10/055,822                |
| Filing Date            | January 23, 2002          |
| First Named Inventor   | Volkmar Schwitzky, et al. |
| Art Unit               | 1762                      |
| Examiner Name          | Parker, Frederick J.      |
| Attorney Docket Number | 103797-238-NP             |

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- ii. ☒ Other Reply to Final Office Action filed November 13, 2003.
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/ Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other \_\_\_\_\_

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed. The Director is hereby authorized to charge the following fees, or credit any overpayments, to
- a. ☒ Deposit Account No. 06-0923

- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_

- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

|                   |                |                                   |                   |
|-------------------|----------------|-----------------------------------|-------------------|
| Name (Print/Type) | Eva Tan        | Registration No. (Attorney/Agent) | 46,406            |
| Signature         | <i>Eva Tan</i> | Date                              | February 17, 2004 |

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|                   |                             |      |                   |
|-------------------|-----------------------------|------|-------------------|
| Name (Print/Type) | Yvette Alvarez-Perez        | Date | February 17, 2004 |
| Signature         | <i>Yvette Alvarez-Perez</i> |      |                   |

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PTO/SB/17 (10-03)

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# FEE TRANSMITTAL

## for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 770.00)

## Complete if Known

Application Number 10/055,822  
 Filing Date January 23, 2002  
 First Named Inventor Volkmar Schwitzky, et al.  
 Examiner Name Parker, Frederick J.  
 Art Unit 1762  
 Attorney Docket No. 103797-238-NP

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:
 Deposit  
 Account  
 Number  
 Deposit  
 Account  
 Name

06-0923

Goodwin Procter LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

| Large Entity<br>Fee Code (\$) | Small Entity<br>Fee Code (\$) | Fee Description        | Fee Paid |
|-------------------------------|-------------------------------|------------------------|----------|
| 1001 770                      | 2001 385                      | Utility filing fee     |          |
| 1002 340                      | 2002 170                      | Design filing fee      |          |
| 1003 530                      | 2003 265                      | Plant filing fee       |          |
| 1004 770                      | 2004 385                      | Reissue filing fee     |          |
| 1005 180                      | 2005 80                       | Provisional filing fee |          |

SUBTOTAL (1) (\$)

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims       | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| Independent        | -20** =      | X              |          |
| Multiple Dependent | -3** =       | X              |          |

| Large Entity<br>Fee Code (\$) | Small Entity<br>Fee Code (\$) | Fee Description  |
|-------------------------------|-------------------------------|--|
| 1202 18                       | 2202 9                        | Claims in excess of 20                                     |
| 1201 86                       | 2201 43                       | Independent claims in excess of 3                          |
| 1203 290                      | 2203 145                      | Multiple dependent claim, if not paid                      |
| 1204 86                       | 2204 43                       | ** Reissue independent claims over original patent         |
| 1205 18                       | 2205 9                        | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

| Large Entity<br>Fee Code (\$) | Small Entity<br>Fee Code (\$) | Fee Description  | Fee Paid |
|-------------------------------|-------------------------------|--|----------|
| 1051 130                      | 2051 65                       | Surcharge - late filing fee or oath  |          |
| 1052 50                       | 2052 25                       | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053 130                      | 2053 130                      | Non-English specification  |          |
| 1812 2,520                    | 2812 2,520                    | For filing a request for ex parte reexamination                            |          |
| 1804 920*                     | 2804 920*                     | Requesting publication of SIR prior to Examiner action                     |          |
| 1805 1,840*                   | 2805 1,840*                   | Requesting publication of SIR after Examiner action                        |          |
| 1251 110                      | 2251 55                       | Extension for reply within first month                                     |          |
| 1252 420                      | 2252 210                      | Extension for reply within second month                                    |          |
| 1253 950                      | 2253 475                      | Extension for reply within third month                                     |          |
| 1254 1,480                    | 2254 740                      | Extension for reply within fourth month                                    |          |
| 1255 2,010                    | 2255 1,005                    | Extension for reply within fifth month                                     |          |
| 1401 330                      | 2401 165                      | Notice of Appeal   |          |
| 1402 330                      | 2402 165                      | Filing a brief in support of an appeal                                     |          |
| 1403 290                      | 2403 145                      | Request for oral hearing   |          |
| 1451 1,510                    | 2451 1,510                    | Petition to institute a public use proceeding                              |          |
| 1452 110                      | 2452 55                       | Petition to revive - unavoidable   |          |
| 1453 1,330                    | 2453 665                      | Petition to revive - unintentional   |          |
| 1501 1,330                    | 2501 665                      | Utility issue fee (or reissue)   |          |
| 1502 480                      | 2502 240                      | Design issue fee   |          |
| 1503 640                      | 2503 320                      | Plant issue fee  |          |
| 1460 130                      | 2460 130                      | Petitions to the Commissioner  |          |
| 1807 50                       | 2807 50                       | Processing fee under 37 CFR 1.17(q)  |          |
| 1808 180                      | 2808 180                      | Submission of Information Disclosure Stmt                                  |          |
| 8021 40                       | 28021 40                      | Recording each patent assignment per property (times number of properties) |          |
| 1809 770                      | 2809 385                      | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810 770                      | 2810 385                      | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801 770                      | 2801 385                      | Request for Continued Examination (RCE)                                    | 770      |
| 1802 900                      | 2802 900                      | Request for expedited examination of a design application                  |          |

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 770.00)

## SUBMITTED BY

Name (Print/Type) Eva Tan

Signature

Registration No.  
(Attorney/Agent)

46,406

(Complete if applicable)

Telephone 973-992-1990

Date

February 17, 2004

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PTO/SB/17 (10-03)

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**FEE TRANSMITTAL**  
**for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 770.00)

**Complete if Known**

|                      |                           |
|----------------------|---------------------------|
| Application Number   | 10/055,822                |
| Filing Date          | January 23, 2002          |
| First Named Inventor | Volkmar Schwitzky, et al. |
| Examiner Name        | Parker, Frederick J.      |
| Art Unit             | 1762                      |
| Attorney Docket No.  | 103797-238-NP             |

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

Deposit Account Number 06-0923

Deposit Account Name Goodwin Procter LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description        | Fee Paid |
|----------------------------|----------------------------|------------------------|----------|
| 1001 770                   | 2001 385                   | Utility filing fee     |          |
| 1002 340                   | 2002 170                   | Design filing fee      |          |
| 1003 530                   | 2003 265                   | Plant filing fee       |          |
| 1004 770                   | 2004 385                   | Reissue filing fee     |          |
| 1005 160                   | 2005 80                    | Provisional filing fee |          |
| SUBTOTAL (1) (\$)          |                            |                        |          |

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims       | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| Independent        | -20** =      | X              |          |
| Multiple Dependent | -3** =       | X              |          |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  |
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| 1202 18                    | 2202 9                     | Claims in excess of 20                                     |
| 1201 86                    | 2201 43                    | Independent claims in excess of 3                          |
| 1203 290                   | 2203 145                   | Multiple dependent claim, if not paid                      |
| 1204 86                    | 2204 43                    | ** Reissue independent claims over original patent         |
| 1205 18                    | 2205 9                     | ** Reissue claims in excess of 20 and over original patent |
| SUBTOTAL (2) (\$)          |                            |  |

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**


| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1051 130                   | 2051 65                    | Surcharge - late filing fee or oath  |          |
| 1052 60                    | 2052 25                    | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053 130                   | 1053 130                   | Non-English specification  |          |
| 1812 2,520                 | 1812 2,520                 | For filing a request for ex parte reexamination                            |          |
| 1804 920*                  | 1804 920*                  | Requesting publication of SIR prior to Examiner action                     |          |
| 1805 1,840*                | 1805 1,840*                | Requesting publication of SIR after Examiner action                        |          |
| 1251 110                   | 2251 55                    | Extension for reply within first month                                     |          |
| 1252 420                   | 2252 210                   | Extension for reply within second month                                    |          |
| 1253 950                   | 2253 475                   | Extension for reply within third month                                     |          |
| 1254 1,480                 | 2254 740                   | Extension for reply within fourth month                                    |          |
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| 1451 1,510                 | 1451 1,510                 | Petition to institute a public use proceeding                              |          |
| 1452 110                   | 2452 55                    | Petition to revive - unavoidable   |          |
| 1453 1,330                 | 2453 665                   | Petition to revive - unintentional   |          |
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| 1460 130                   | 1460 130                   | Petitions to the Commissioner  |          |
| 1807 50                    | 1807 50                    | Processing fee under 37 CFR 1.17(a)  |          |
| 1808 180                   | 1808 180                   | Submission of Information Disclosure Stmt                                  |          |
| 8021 40                    | 8021 40                    | Recording each patent assignment per property (times number of properties) |          |
| 1809 770                   | 2809 385                   | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810 770                   | 2810 385                   | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801 770                   | 2801 385                   | Request for Continued Examination (RCE)                                    | 770      |
| 1802 900                   | 1802 900                   | Request for expedited examination of a design application                  |          |

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 770.00)

**SUBMITTED BY**

|                   |   |                                   |                   |           |              |
|-------------------|---|-----------------------------------|-------------------|-----------|--------------|
| Name (Print/Type) | Eva Tan   | Registration No. (Attorney/Agent) | 46,406            | Telephone | 973-992-1990 |
| Signature         |  | Date                              | February 17, 2004 |           |              |

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